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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Application Serial No. 76/529,077
Published in the *Official Gazette* (Trademarks) on May 8, 2007

CAKE DIVAS,

Opposer

v.

CHARMAINE V. JONES,

Applicant.

Opposition No. 91177301

APPLICANT'S BRIEF ON THE MERITS

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I. SUMMARY OF THE ARGUMENT

Applicant Charmaine V. Jones has used the trademark CAKEDIVA in commerce continuously since at least as early as 1993. Applicant began using the CAKEDIVA mark nearly five years before Opposer allegedly began to use the nearly identical CAKE DIVAS mark, on October 15, 1998. The record is replete with both documentary and testimonial evidence of Applicant's use of the CAKEDIVA mark in connection with the sale of cakes, cookies, and edible sugar sculptures, among other things, from 1993 to the present. Opposer's wholly unsupported assertion in its brief to the contrary – that Applicant allegedly has produced *no* evidence of use prior to 1998 – is extraordinarily puzzling, given that the evidence overwhelmingly demonstrates Applicant's priority in the CAKEDIVA mark.

Accordingly, Opposer's Opposition to Applicant's Trademark Application Serial No. 76/529,077 ("Applicant's Application") should be denied.

II. DESCRIPTION OF THE RECORD

A. Evidence Submitted By Applicant

Applicant's Notice of Reliance, at Docket No. 42, dated October 2, 2009, including a Gary, Indiana newspaper article dated September 1, 1994.

The testimony of Ashbell McElveen ("Mr. McElveen" or "Chef Ashbell") dated October 1, 2009 ("McElveen Dep.")¹, a celebrity chef and television personality who appeared on the *Today Show* from 1990 until 1993, and the owner of a food website located at www.foodstop.com from 1993 or 1994 through 2002, along with Exhibit 1 to the McElveen Deposition, a screen shot of the FOODSTOP homepage from 1996.

¹ Citations to "McElveen Dep." refer to the testimony deposition of Ashbell J. McElveen, a/k/a "Chef Ashbell" whose testimony was taken on behalf of Applicant and is on record at Docket No. 43.

B. Evidence Submitted By Opposer

Opposer's Notice of Reliance, dated April 30, 2009, containing Applicant's Responses and Objections to Opposer's Interrogatories, and documents Bates Stamped CD00007-16 and CD00026-122², and deposition testimony described in Opposer's Brief ("Opposer Br.").

III. STATEMENT OF ISSUES

1. Whether Opposer Has Met Its Burden Of Proving Priority In the CAKE DIVAS Mark, In Light Of The Substantial Evidence Of Applicant's Use Of The CAKEDIVA Mark Prior To 1998?
2. Whether Opposer May Raise Fraud Now, After Failing To Plead It?

IV. STATEMENT OF FACTS

A. Applicant's July 11, 2003 Application To Register The CAKEDIVA Mark

On July 11, 2003, Charmaine Jones ("Applicant" or "Ms. Jones") filed Applicant's Application to register the trademark CAKEDIVA. As sworn to in Applicant's Application, Ms. Jones had been using the CAKEDIVA mark in commerce since June 15, 1993 in connection with Applicant's Goods (defined below). Accordingly, Applicant claimed a first use date of June 15, 1993.

Applicant's Application identified goods in two classes: (1) International Class 30, "Cakes, namely, wedding cakes, bridal shower cakes, party cakes, novelty cakes and cakes for all occasions; edible cake sculptures of all shapes and sizes made primarily of sugar; cookies of all shapes and sizes; edible sugar sculptures in the form of flowers, inanimate objects, human images; and edible decorations made of sugar for cakes and cookies" (hereinafter "Applicant's Cakes"); and, (2) International Class 16, "Greeting cards featuring photographs of cakes and

² Citations to documents contained in Opposer's Notice of Reliance appear herein as "(CD000---)."

cookies” (“Applicant’s Greeting Cards”).³ (Hereinafter Applicant’s Cakes and Applicant’s Greeting Cards are referred to as “Applicant’s Goods”).

Applicant’s Application was published for opposition on May 8, 2007.

B. Opposer’s Subsequent August 6, 2003 Application To Register The CAKE DIVAS Mark

Approximately one month after Ms. Jones filed her application to register the CAKEDIVA mark, Opposer filed an application to register CAKE DIVAS as a trademark, on August 6, 2003 (Serial No. 76/538360) (“Opposer’s Application”). Opposer’s Application claimed a first use date of October 15, 1998, more than five years after Applicant’s claimed first use date.

Opposer’s Application identified the following services in International Class 40, “Custom cake making, baking, designing and decorating services for edible and faux cakes” (“Opposer’s Services”).

Opposer’s Application has not been published, but rather has been suspended since October 25, 2005 in view of the prior pending Applicant’s Application. One week after Applicant’s Application was published, Opposer filed the instant Opposition (No. 91177301), on May 15, 2007.

C. Applicant’s Continuous Use Of The CAKEDIVA Mark In Commerce Prior To 1998

Ms. Jones has used the CAKEDIVA mark in connection with Applicant’s Cakes since at least as early as 1993 and in any case long before Opposer’s alleged first use date of October 15, 1998.

³ Examples of Applicant’s Greeting Cards and advertisements for Applicant’s Greeting Cards are included in the record. (See, e.g., CD00011, CD00036).

Ms. Jones adopted the CAKEDIVA mark in the early 1990s, while running her ISN'T THAT SPECIAL OUTRAGEOUS CAKES business. She opened a bakery in Hoboken, New Jersey in approximately 1990, which she later turned into a cake gallery featuring Applicant's Cakes. (CD00086). Ms. Jones not only sold cakes under the CAKEDIVA mark, she also created an alter-ego for herself called the CAKEDIVA, which she used to generate hype and draw consumer interest for her cakes sold under the CAKEDIVA mark. A former model, Ms. Jones is a striking African American woman standing over 6 feet tall. As CAKEDIVA she donned a tall blonde bouffant wig, and glamorous clothing designed to showcase herself as a "diva." (*See, e.g.*, CD00007).

In the early 1990s, dressed as CAKEDIVA, Ms. Jones loaded her cakes for delivery in a beat-up old station wagon that she named "Baby Huey." She wrote stories about her adventures delivering cakes in Baby Huey as CAKEDIVA, which she used to promote her cakes and the CAKEDIVA mark. (McElveen Dep. at 29-30). From the relatively humble trappings of Baby Huey, Ms. Jones, as the extravagant CAKEDIVA, would emerge, delivering her cakes to fabulous houses. (McElveen Dep. at 30). It is therefore not surprising that her deliveries and her CAKEDIVA persona became as memorable as Applicant's Cakes, and that the CAKEDIVA mark became more well known and associated with her cakes than her official business name, ISN'T THAT SPECIAL OUTRAGEOUS CAKES. Capitalizing on this recognition, Ms. Jones increasingly promoted the CAKEDIVA mark in connection with her cakes, and by 1993 or 1994, ultimately came to rely on the CAKEDIVA mark as the primary mark for identifying the source of Applicant's Goods.

The CAKEDIVA mark and the CAKEDIVA persona Ms. Jones created to promote Applicant's Cakes, have formed the cornerstone of Ms. Jones' business since the early 1990s

into the present day. To promote her CAKEDIVA mark in connection with her cakes, Ms. Jones dressed as CAKEDIVA when attending trade shows, making public appearances, and while being photographed for magazines, in addition to when she delivered her cakes. (*See, e.g.*, CD00007, CD00047-48). As CAKEDIVA, Applicant's Cakes were featured on the *Today* show through her business acquaintance, Chef Ashbell, who was a featured food personality on that show from 1990-1993. (McElveen Dep. at 27). She used the CAKEDIVA mark in connection with her cakes on promotional materials and on the Internet. (*See, e.g.*, McElveen Dep. Ex. 1; CD00046, CD00044). On the Internet, she relied on the CAKEDIVA story, including the tales of her adventures delivering cakes, which she referred to as "The Adventures of Cake Diva," to create a legend behind her cakes and the CAKEDIVA mark, which she used to further market and promote the CAKEDIVA mark in connection with Applicant's Cakes. (*See, e.g.*, McElveen Dep. at 29-30; CD00013).

Ms. Jones' CAKEDIVA mark first appeared on an Internet website located at www.foodstop.com, that went live at the end of 1993 or early 1994. (McElveen Dep. at 8). Chef Ashbell, a former restaurant owner, celebrity chef and television personality who covered cooking and food style information on the *Today Show* from 1990 to 1993, started the FOODSTOP website immediately after leaving the *Today Show* in late 1993 or early 1994. (McElveen Dep. at 5-6, 8). Mr. McElveen controlled the content of the FOODSTOP website. (McElveen Dep. at 8). The FOODSTOP website was global and received hits from all over the United States as well as Western Europe. (McElveen Dep. at 23).

Beginning in late 1993 or early 1994, the homepage at www.foodstop.com prominently displayed the CAKEDIVA mark. (McElveen Dep. at 25-26; *see also* McElveen Dep. at Exhibit 1). The display of the CAKEDIVA mark included a link to a webpage providing information

about Applicant's Cakes and providing information for contacting CAKEDIVA about Applicant's Cakes. (McElveen Dep. at 21, 25). Ms. Jones' promotion of the CAKEDIVA mark in connection with her cakes on this globally accessed website led to numerous inquiries regarding her cakes and requesting information about CAKEDIVA. (McElveen Dep. at 22, 42). The CAKEDIVA mark appeared continuously on this website for as long as the site was active, which was until 2002. (McElveen Dep. at 26). In or around 1999, Ms. Jones developed her own website located at www.cakediva.com, on which she has continuously displayed the CAKEDIVA mark in association with Applicant's Cakes from 1999 until the present day. (CD0026). In 1999, when Applicant developed her own website, the CAKEDIVA mark was shifted to a link at the bottom of the page of the FOODSTOP website, but it still appeared on the homepage. (McElveen Dep. at 32-33).

As a result of Ms. Jones' use and promotion of the CAKEDIVA mark in association with her cakes, Ms. Jones, her CAKEDIVA mark and Applicant's Cakes have received considerable publicity and significant media attention since 1993, much of which pre-dates Opposer's claimed first use date in October 1998. For instance, Ms. Jones' cake in the shape of a cornucopia was featured on the *Today* show sometime between 1990 and 1993 and was referred to as having been made by CAKEDIVA. (McElveen Dep. at 5, 28). Ms. Jones was featured in her hometown newspaper from Gary, Indiana, in a September 1, 1994 article referring to her as CAKEDIVA. (Applicant's Notice of Reliance). This same article detailed several of her famous clients, including Jay Leno, Michael Jordan, Joan Rivers and Geraldo Rivera. (Applicant's Notice of Reliance). For example, she made a cake to celebrate Jay Leno's first year as host of the *Tonight Show*, which was in 1993 (CD00103), and another cake to celebrate Geraldo

Rivera's 50th Birthday also in 1993 (CD000103). As early as 1994, another article noted that Ms. Jones was affectionately known as the CAKEDIVA. (CD000105).

In order to ensure that people knew the source of her cakes, when Ms. Jones delivered her custom made cakes she would display the cake with a card bearing her CAKEDIVA trademark and contact information in the form of her phone number. The evidence shows that this was her practice at least as early as 1995. (McElveen Dep. at 31). Even when Ms. Jones did not deliver her cakes in person, she made sure that the person delivering the cake displayed her card with the CAKEDIVA mark next to the cake as part of setting it up. For example, she enlisted the help of a friend to deliver one of her cakes, and he followed her regular procedure of setting up the cake with the CAKEDIVA card display bearing the CAKEDIVA mark. (McElveen Dep. at 30-31).

Ms. Jones' promotional pieces for her cake business have relied on and specifically included the CAKEDIVA mark since at least as early as 1993. (CD0010, CD00044, CD00043). Additional publicity specifically referring to Ms. Jones' cake business in association with the CAKEDIVA mark date back to 1993. (CD0043-46). Evidence in the record shows additional references in advertising and publicity pre-dating October 1998. (*See, e.g.*, CD0047-50).

In an interview from May 1997, Ms. Jones was quoted as saying that she wants the CAKEDIVA mark to become a household name. (CD00103).

All of the above took place well before Opposer's claimed date of first use in October 1998 and is amply supported by evidence in the record.

V. ARGUMENT

A. Opposer Has Not Met Its Burden Of Proving Priority

Opposer has the burden of proving its priority of use of the CAKE DIVAS mark. *Dyneer Corp. v. Auto. Prods. Plc*, 37 U.S.P.Q.2d 1251, 1257 (TTAB 1995) ("we note that opposer will have the burden, at trial, of proving its standing and likelihood of confusion, in addition to its

priority of use.”). Here, Opposer has not carried its burden. Opposer has alleged a first use date of October 15, 1998. All of Opposer’s evidence has gone towards establishing Opposer’s use of the CAKE DIVAS mark on or after October 1998. Opposer has not put in a single piece of evidence showing use of the CAKE DIVAS mark before October 1998.

Even assuming *arguendo* the validity of Opposer’s alleged first use date of October 1998, Opposer has failed to meet its burden of establishing priority, in light of the substantial evidence of Applicant’s continuous use of the CAKEDIVA mark well before 1998. In fact, documentary and testimonial evidence in the record establish that Applicant used the CAKEDIVA mark at least as early as 1993 in connection with the sale and promotion of Applicant’s Cakes, and then continuously thereafter through the present day. Not only has Opposer failed to provide any evidence of its use predating Applicant’s use, in its brief Opposer also totally ignores the evidence of Applicant’s prior use in the record, and fails to make even an attempt at arguing against it. Unfortunately for Opposer, blindly ignoring the evidence of Applicant’s prior use of the CAKEDIVA mark will not make it go away.

By failing to submit evidence of any use of the CAKE DIVAS mark before 1998, and by failing to address the substantial evidence of Applicant’s prior and continuous use of the CAKEDIVA mark from as early as 1993, Opposer has failed to meet its burden of establishing priority. Consequently, Opposer’s opposition must be denied.

B. Applicant Has Priority In The CAKEDIVA Trademark Based On Applicant’s Prior And Continuous Use Of The Mark Before October 1998, The Alleged First Use Date Of Opposer’s CAKE DIVAS Mark

A party may establish its own prior proprietary rights in a mark through actual use or use analogous to trademark use. *See, e.g., Westrex Corp. v. New Sensor Corp.*, 83 U.S.P.Q.2d 1215, 1217 (TTAB 2007); *Dynamet Tech., Inc. v. Dynamet Inc.*, 197 U.S.P.Q. 702, 711 (TTAB 1977).

As discussed in detail below, the evidence demonstrates that Applicant was the first to use the CAKEDIVA mark, as early as 1993, and consequently, Applicant has priority over Opposer.

1. Applicant Has Priority Based On Her Use of the CAKEDIVA Mark Before October 1998

a. *Applicable Law*

For goods, “a mark shall be deemed to be in use in commerce ... [when] it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impractical, then on documents associated with the goods or their sale, [and] the goods are sold or transported in commerce....” 15 U.S.C. §1127; *see also In re Supply Guys Inc.*, 86 U.S.P.Q.2d 1488, 1491 (TTAB 2008). The use of a mark on a “‘display associated with the goods’ is equivalent to affixation of the mark to the goods or packages therefor for the purpose of creating technical trademark rights.” *Harley Davidson Motor Co., Inc. v. Pierce Foods Corp.*, 231 U.S.P.Q. 857, 862 (TTAB 1986). The display of the alleged mark must “be such that purchasers would relate it to the goods, whether or not they are in proximity to the display.” *Id.* at 862; *see also* Trademark Manual of Examining Procedure (“TMEP”) § 904.03(g) (“The display must be related to the sale of the goods such that an association of the two is inevitable.”).

A website page “that displays a product and provides a means of ordering the product, can constitute a ‘display associated with the goods,’ as long as the mark appears on the web page in a manner in which the mark is associated with the goods, and the web page provides a means for ordering the goods.” *In re Supply Guys*, 86 U.S.P.Q. at 1492; *see also In re Osterberg*, 83 U.S.P.Q.2d 1220, 1223 (2007). The TTAB has held that “web pages that display goods and their trademarks and provide for online ordering of such goods are, in fact, electronic displays which are associated with the goods.” *In re Supply Guys*, 86 U.S.P.Q. at 1492. “Such uses are not

merely advertising, because in addition to showing the goods, they provide a link for ordering the goods.” *Id.* As such, the web page “is thus a point of sale display by which an actual sale is made.” *Id.* A court “must look to the perception of the ordinary customer to determine whether the term [on a website] functions as a trademark.” *In re Supply Guys*, 86 U.S.P.Q. at 1496.

b. Evidence of Applicant’s Use of the *CAKEDIVA* Mark

Applicant has provided a wealth of documentary and testimonial evidence of Applicant’s use of the *CAKEDIVA* mark in connection with the sale or transport in commerce of Applicant’s Cakes prior to 1998, as well as her use of the *CAKEDIVA* mark to designate the source of her cakes. The record shows that it was Applicant’s practice to display her cakes with a card bearing the *CAKEDIVA* mark. When Applicant had others deliver her cakes for her, she instructed them to follow her standard practice of displaying the *CAKEDIVA* mark with the cakes by placing a card bearing the *CAKEDIVA* mark next to the cakes. Mr. McElveen testified that in approximately 1993 he recalled seeing cards with cakes on them bearing the *CAKEDIVA* mark. (McElveen Dep. at 40). He also testified that in 1995 or 1994, he delivered a cake for a wedding at a Masonic Hall on behalf of Ms. Jones, who was out of town. (McElveen Dep. at 30). Applicant gave Mr. McElveen cards to leave with the cake, and she also provided him with a diagram to follow in setting up the cake and sugar flowers. (*Id.*). Mr. McElveen testified, “I did what she did, and I put the cards next to the cake.” (*Id.*). The cards contained the *CAKEDIVA* mark, an image of Applicant “in a wig as Cake Diva, in this big blonde wig and very nicely dressed and looking extravagant,” and Applicant’s phone number. (McElveen Dep. at 30-31).

Applicant displayed cards bearing the *CAKEDIVA* mark alongside her cakes because it was impractical to affix the *CAKEDIVA* mark to the cakes themselves. In addition, many of her

cakes were large, elaborate structures, making it also impractical to transport the cakes in any type of standard packaging or container. Mr. McElveen testified as to the impracticality and commercial undesirability of Applicant affixing the CAKEDIVA mark to Applicant's Cakes:

Q. On any of the cakes she produced, did she have Cake Diva [sic] fixed on any of those cakes, fixed as in written on the cake or a label on the cake?

A. Well, if you are a bride and it's your wedding, you probably didn't want Cake Diva [sic] to have her logo on your wedding cake, so I didn't see that ever.

Q. Have you ever seen it ever on a cake that she produced?

A. I have never seen it on anybody's cake, Joe's Bakery.

(McElveen Dep. at 39). In light of the impracticality of affixing her CAKEDIVA mark to the cakes themselves, Applicant's practice of displaying cards with the CAKEDIVA mark with her cakes makes both commercial and aesthetic sense.

Applicant also displayed her CAKEDIVA mark in association with Applicant's Cakes on the Internet prior to 1998, and provided a means to order Applicant's Cakes. Since 1993 or 1994 until approximately 2002, Applicant displayed the CAKEDIVA mark in association with Applicant's Cakes on the FOODSTOP webpage located at www.foodstop.com. (McElveen Dep. at 8-9, 21-26; McElveen Dep. Ex. 1). The CAKEDIVA mark appeared continuously on the FOODSTOP website for as long as the site was active. (McElveen Dep. at 26).

Exhibit 1 to the McElveen Deposition is a screen shot of the FOODSTOP homepage from 1996. (McElveen Dep. at 9, 14-15). The screen shot of the homepage shows a box containing the CAKEDIVA mark midway down on the left-hand column next to a stylized image of a tiered cake. (McElveen Dep. Ex. 1). Mr. McElveen, the owner of the website and the manager of its content, testified that the box functioned as a link that web users could click on. If a user clicked on the CAKEDIVA link, the user would be brought to an information page

containing a biography of CAKEDIVA. (McElveen Dep. 21).⁴ The information page had a title bar across the top of it with the term FOODSTOP on one side and the CAKEDIVA mark displayed on the other side. (McElveen Dep. 21). From the information page, users could click on a link to the “Cake Gallery,” which featured photographs of Applicant’s Cakes. (McElveen Dep. at 21-22). Mr. McElveen testified that the Cake Gallery contained pictures of cakes Applicant had designed, that “she had done for clients.” (McElveen Dep. at 24). The bar at the top of the Cake Gallery Page contained the CAKEDIVA mark. (McElveen Dep. at 24). At the bottom of the Cake Gallery page, there was a phone number potential customers could use to contact “Cake Diva” regarding her cakes. (McElveen Dep. at 22, 25).

The FOODSTOP website, including the homepage and the linked CAKEDIVA pages about which Mr. McElveen testified, displayed the CAKEDIVA mark in association with Applicant’s Cakes. An ordinary consumer viewing the FOODSTOP home page with the CAKEDIVA mark displayed in the left-hand margin, and the pages linked to it, including the information page about CAKEDIVA and the Cake Gallery displaying pictures of Applicant’s Cakes, would conclude that the CAKEDIVA mark was being used as a trademark in association with goods – the photographed cakes – being featured. There is a direct association between the mark CAKEDIVA and the featured cakes, as both deal with cakes. Moreover, on the homepage the CAKEDIVA mark was featured prominently in a separate box in the left-hand column of the page, along with a stylized image of a cake. (McElveen Dep. Ex. 1).

⁴ At Mr. McElveen’s deposition, counsel for Opposer made an objection to the linked pages – but not to the produced screenshot of the homepage – not having been produced. However, Opposer questioned Mr. McElveen about the contents of those linked pages asking him to pull “from [his] recollection.” (McElveen Dep. 35). Applicant relies on Mr. McElveen’s testimony, based on his recollection of the FOODSTOP homepage and the linked pages providing information about CAKEDIVA, in support of its argument that Applicant has priority to the CAKEDIVA mark. There is no basis upon which to object to such testimony, and in any case, Opposer waived any such objection by continuing to ask questions regarding those linked CAKEDIVA pages based on Mr. McElveen’s recollection.

The FOODSTOP website also provided a means of ordering Applicant's Cakes, as it had a phone number to contact Applicant regarding the cakes at the bottom of the page containing the Cake Gallery. (McElveen Dep. at 21-22). Mr. McElveen testified that the text next to the phone number referred specifically to CAKEDIVA, and not to getting in touch with Ms. Jones. (McElveen Dep. at 36).

- Q. And then there was phone number and e-mail on the gallery. Did I hear you correctly?
- A. Yes, it was a phone number. No e-mail.
- Q. It said – the text next to the phone number was about getting in touch with Charmaine Jones; is that correct?
- A. No, **the text next to the phone number was for information about Cake Diva cakes**, and it was a New York number and a New Jersey number, if I recall.

(McElveen Dep. at 36). Mr. McElveen explained that the page did not state that the cakes were offered for sale because the FOODSTOP website was not selling the cakes. (McElveen Dep. at 37). Nonetheless, the website provided a means for ordering Applicant's Cakes, because potential purchasers interested in ordering a CAKEDIVA cake had only to call the number listed at the bottom of the Cake Gallery in order to place an order for Applicant's Cakes.

Applicant's use and promotion of the CAKEDIVA mark in connection with her cakes on the FOODSTOP website led to numerous e-mail inquiries regarding Applicant's Cakes and requesting information about CAKEDIVA. (McElveen Dep. 22, 42-43). In 1996 alone, Mr. McElveen recalled receiving approximately thirty e-mails from potential customers of Applicant asking, "How do you get in touch with Cake Diva, and how do I get a cake." (McElveen Dep. 22). Potential consumers "referred to [Applicant] as the Cake Diva, because that was what was on the site." (McElveen Dep. at 42).⁵ Mr. McElveen also testified that he received many e-mails

⁵ Mr. McElveen further testified that at the time, in or about 1996, Ms. Jones did not have access to e-mail, and in order to get the messages to Ms. Jones, he would have to call her and relay the message. (McElveen Dep. at

requesting recipes for Applicant's Cakes. (McElveen Dep. 27). However, because selling cakes was Applicant's livelihood, Mr. McElveen testified that Applicant did not give out her recipes. (*Id.*) ("[t]here was a lot of them, and so much so that it almost became my junk e-mail, asking for recipes, because she was clearly selling the cakes and that was her livelihood, so she was not going to give out recipes of how to make a sugar flower.").

As further evidence of Applicant's widespread and continuous use of the CAKEDIVA mark prior to 1998, Applicant and her cakes, in connection with the CAKEDIVA mark, received significant publicity. Stories about sales and deliveries of Applicant's Cakes prior to 1998 in connection with the CAKEDIVA mark were featured on nationally televised programming, and in numerous magazines with national distribution and newspapers from different parts of the United States. For instance, Mr. McElveen testified that "as the Cake Diva," Ms. Jones' cake in the shape of a cornucopia was featured on the *Today* show sometime between 1990 and 1993. (McElveen Dep. at 5, 28). Mr. McElveen also testified to a wedding reception event Applicant and he did together in 1992 or 1993, where Applicant made the cake, and it was written up in the New York Times. (McElveen Dep. at 28).

In 1994, a Gary, Indiana newspaper featured a story about Applicant and her cakes referring to her as "**cake diva**" and "the **cake diva** of New York." (Applicant's Notice of Reliance). The article reported that Applicant had been in the cake making business since 1990 and "baked over 750 cakes for as little as \$150 and as much as \$3,000." (*Id.*). In addition, as of September 1994, it was known that Applicant had "been commissioned to bake for the Jay Leno

22-23). In the early 1990s, in the infancy of the Internet, it was not yet common for people and business to have e-mail, much less for websites to be equipped with online order forms where consumers could purchase a product with only a click of a button. Rather, websites – like the FOODSTOP website – provided contact information for potential consumers to use to order goods.

Show, Michael Jordan, the Joan Rivers Show, [and] Geraldo Rivera” and one of her cakes had appeared in *Essence* magazine. (*Id.*). Also in 1994, the May/June 1994 edition of *Sugarcraft Magazine* featured an article on Applicant’s Cakes in which it reported that Applicant was “[a]ffectionately known as the ‘**cake diva.**’” (CD000105). Similarly, in the Spring/Summer 1996 edition of *Wedding Dresses Magazine*, an article about Applicant’s Cakes reported that Ms. Jones, “affectionately known as the ‘**cake diva**’ is leading the nation into very unique cake styles.” (CD00047).

In May of 1997, an interview with Applicant appeared in *Black Diaspora Magazine*, entitled “Charmaine Jones The **Cake Diva** of Outrageous Cakes.” (CD000102). The article detailed Ms. Jones’ “successful cake business,” and described how her cakes had been featured, as of 1997, among other things, on television weddings, including daytime soap operas “One Life to Live” and “All My Children.” (CD00102-103). The article also explained that Ms. Jones “wants to take her business onto the next plateau **hope-fully becoming a household name, Cake Diva.**” (CD00103). Additionally, an article from *Food Arts Magazine*, dated October 2000, referring to Ms. Jones as CAKEDIVA, described how Applicant had created a cake with a tank of live goldfish as one of the layers for the opening of the Atlantis Paradise Island in the Bahamas in 1998, and a cake in the form of the bust of Michael Jackson for *People* magazine in 1997. (CD00092-95).

Based on Applicant’s evidence of use of the CAKEDIVA mark dating back to 1993, which occurred well before Opposer’s alleged first use date of the CAKE DIVAS mark in late 1998, Opposer’s Opposition to Applicant’s Application should be denied.

2. Applicant Has Priority Based On Her Use Analogous To Trademark Use Of The CAKEDIVA Mark Before October 1998

c. Applicable Law

“While technical trademark use in commerce is a requisite for federal registration, the use required to establish prior rights in a mark need not be in a technical trademark sense.” *Asplundh Tree Expert Co. v. Defibrator Fiberboard Aktiebolag*, 208 U.S.P.Q. 954, 958 (TTAB 1980). “Use ‘analogous’ to trademark use means use of a nature and extent such as to create an association of the term with the user’s goods.” *Malcolm Nicol & Co., Inc. v. Witco Corp.*, 11 U.S.P.Q.2d 1638, 1639 (Fed. Cir. 1989). “A showing of analogous use does not require direct proof of an association in the public mind.” *Herbko Int’l, Inc. v. Kappa Books Inc.*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002). However, “the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later use acquires proprietary rights in a mark.” *Id.*

To constitute use analogous to trademark use, the use “must be an open and notorious public use directed to the segment of the purchasing public for whom the services (products) are intended, and must be used in a manner sufficient to demonstrate an intention to appropriate the particular word or symbol as an indication of origin for a particular service (product) and to inform or apprise prospective purchasers of the present or future availability of the adopter’s service (product) under the mark.” *Dynamet Tech., Inc.*, 197 U.S.P.Q. at 705-06 (citation omitted); *see also Gio. Buton & C.S.p.A. v. Buitoni Foods Corp.*, 205 U.S.P.Q. 477, 481 (TTAB 1979). In *Dynamet*, the Board found that the defendant possessed superior rights in the mark where it had adopted the term as a salient feature of its trade name prior to plaintiff’s entry into the field, and made open and notorious use of the term in connection with the promotion of its corporate activities including contact with potential customers, prior to similar actions by plaintiff. *Id.* at 711.

A party may establish its own prior proprietary rights in a mark through use analogous to trademark use such as “use in advertising, use as a grade mark, use as the distinguishing feature of a name, and any other use of a designation in a manner calculated to attract the attention of potential customers or customers and to create an association of the mark, an exclusive one, with the product or products of a single, albeit anonymous, producer.” *Dynamet Tech., Inc.*, 197 U.S.P.Q. at 705; *see also Malcolm Nicol & Co., Inc.*, 11 U.S.P.Q.2d at 1639 (proof of proprietary rights in an opposition founded on section 2(d) of the Lanham Act could consist of “prior use in advertising, or as a trade name, or any other type of use which has resulted in establishing a trade identity”). “[W]hile a party may rely on advertising and promotional use of a term or slogan to show superior rights over a subsequent trademark use of a term, the prior advertising must have been of such nature and extent that the term or slogan has become popularized in the public mind.” *Id.* (citing *Jim Dandy Co. v. Martha White Foods, Inc.*, 173 U.S.P.Q. 673, 674 (C.C.P.A. 1972)). Use of a mark on an Internet web site may constitute use analogous to trademark use. *See, e.g., Westrex Corp.*, 83 U.S.P.Q.2d at 1217 (“A party may establish its own prior proprietary rights in a mark ... through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspapers advertisements, and Internet web sites which create a public awareness of the designation as a trademark identifying the party as a source.”).

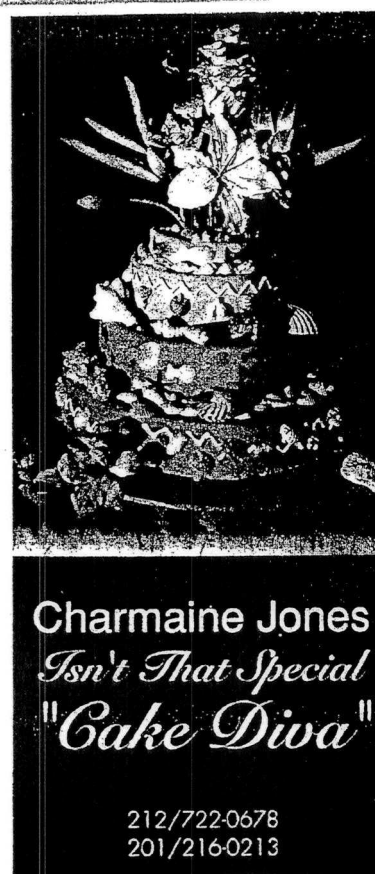
d. Evidence of Applicant’s Use Analogous To Use

Applicant has extensively advertised Applicant’s Cakes in association with the CAKEDIVA mark since at least as early as March of 1993. The record contains a number of examples of advertisements and promotions for Applicant’s Cakes in association with the CAKEDIVA mark prior to 1998. For example, the March 1993 edition of *Brides Today* contains a half-page full-length advertisement for Applicant’s Cakes in association with the CAKEDIVA

mark. (CD00045-46). The advertisement contains a photograph of an elaborately decorated tiered cake and contains the text “Charmaine Jones” “Isn’t that Special” and “Cake Diva.” The words CAKE DIVA are the only words set off by quotation marks, and they are the largest words in the advertisement, in addition to being both bolded and italicized. The size of the text, the quotation marks, and the type of font used set off the CAKEDIVA mark from the other text in the advertisement, and draw the eye of the reader to the CAKEDIVA mark. (CD00046).



Brides Today, March 1993 (CD00046)



Brides Today, 6/15/93 (CD00044)

Similarly, the June 15, 1993 edition of *Brides Today*, which included an article about Applicant’s Cakes under the title “Unique Cakes,” and featured her recipe for “The Black Cake,” contained an advertisement for Applicant’s Cakes using the CAKEDIVA mark. (CD00043-44). There again, the most prominent text of the advertisement are the words CAKE DIVA. The

words CAKE DIVA are the only words set off by quotation marks, they appear in the largest font, both bold and italicized, and they naturally draw the reader's eye, directly associating Applicant's Cakes with the CAKEDIVA mark.⁶

Since adopting the CAKEDIVA mark in the early 1990s, Applicant has made "open and notorious public use" of the CAKEDIVA mark in connection with Applicant's Cakes. As discussed in detail above, Applicant used the CAKEDIVA mark in connection with her cakes, *inter alia*, in printed advertisements, on cards that she displayed with her cakes, and on the Internet to promote Applicant's Cakes.

Her use of the CAKEDIVA mark was directed at the segment of the purchasing public for whom her cakes were intended: prospective brides, wedding planners, celebrity clients, and anyone else looking to include a fabulous cake for their special occasion. As is amply demonstrated by the significant publicity Applicant's Cakes in association with the CAKEDIVA mark received since the early to mid 1990s, Applicant's use of the CAKEDIVA mark made – and is continuing to make – a substantial impact on the public. Her advertisements promoting the CAKEDIVA mark in connection with her cakes appeared in magazines with national distribution, and in newspapers from different parts of the United States, including Indiana and New York. Through her Internet presence, which has been constant since 1993 or 1994, Applicant has promoted the CAKEDIVA mark in connection with her cakes to a global

⁶ Opposer appears to contend in its brief that Applicant used the name of her business, Isn't That Special Outrageous Cakes, as a trademark, rather than the CAKEDIVA mark, and brushes off the significant amounts of publicity regarding Applicant's use of the CAKEDIVA mark in connection with her cakes as "colloquial" references. (Opposer Br. 3). However, as the advertisements for Applicant's Cakes demonstrate, Applicant used the CAKEDIVA mark as the most prominent feature of her advertisements to promote her cakes. Although some of her advertisements also contain her business name, or a portion thereof, the most prominently displayed wording in Applicant's advertisements for her cakes is the CAKEDIVA mark. Moreover, even if Applicant had used Isn't That Special Outrageous Cakes as a trademark, there is nothing that prevents the use of two trademarks in connection with a category of goods.

audience, and as a result has delivered cakes internationally as well as nationally.⁷

The creation of her alter-ego, CAKEDIVA, is a further example of Applicant's open and notorious promotion of the CAKEDIVA mark. She not only adopted the mark, she created a persona based upon the mark calculated to attract the attention of potential customers, and to create an association in the minds of potential customers between the CAKEDIVA mark and Applicant's Cakes. Her use and promotion of the CAKEDIVA mark demonstrate that, since the early 1990s, it was her intention to appropriate the CAKEDIVA mark for her cakes, and that she in fact did so, to great success and much publicity.⁸

C. Opposer Has Failed To Establish Likelihood Of Confusion With Respect To Applicant's Greeting Cards

Opposer's Notice of Opposition lists only Applicant's Cakes as those affected by the opposition. Consequently, there is no opposition to the CAKEDIVA mark in connection with Applicant's Greeting Cards, and Opposer's Opposition should be denied on this basis.

In addition, Opposer has failed to establish likelihood of confusion with respect to Applicant's Greeting Cards. One factor to be considered is the "similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." *Herbko Int'l, Inc.*, 64 U.S.P.Q.2d at 1381 (citation omitted). This

⁷ As further evidence of Applicant's sales of Applicant's Cakes in connection with the CAKEDIVA mark, in Interrogatory Response No. 3 Applicant stated that Applicant's Goods "have been advertised, promoted, sold and/or distributed internationally, including without limitation in Telford, England in 2001, in Brazil in approximately 2000-01, and in the Caribbean in approximately 1997-98. (Applicant's Responses and Objections to Opposer's Interrogatories submitted with Opposer's Notice of Reliance at Docket No. 27).

⁸ The record contains an invoice showing Applicant's purchase, on October 25, 2002, of 1,200 labels bearing the CAKEDIVA mark in gold ink on a white label, and a sample label. (CD00015-16). In light of the substantial evidence of Applicant's use of the CAKEDIVA mark discussed herein, and the evidence in the record of Applicant's continuous use of the mark after 1998, such as her purchase of CAKEDIVA labels, this case is not one in which there has been any delay – certainly not more than a commercially reasonable delay – between use analogous to trademark use and actual use. Consequently, the evidence of Applicant's use unequivocally establishes her priority to the CAKEDIVA mark.

factor looks at the similarity of the parties' goods. Here, Opposer has not put forth any evidence regarding this factor, nor any of the *Dupont* factors, with regard to Applicant's Greeting Cards. *See, e.g., In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

Accordingly, Opposer's Opposition should be denied.

D. There Is No Basis For Denying Registration on Grounds of Fraud

1. Opposer Did Not Plead Fraud As a Ground for Opposition

This opposition was based solely upon Opposer's alleged prior rights and likelihood of confusion. The Notice of Opposition makes no allegation concerning any fraud by Applicant. Opposer never sought to amend the Notice of Opposition.

It is fundamental that "a plaintiff may not rely upon an unpleaded claim." Trademark Board Manual of Procedure ("TBMP") §314. Numerous decisions have refused to consider issues raised by parties in final briefs where the issue was never pleaded. *See, e.g., Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 U.S.P.Q.2d 1423, 1439-40 (TTAB 1993) (refusing to consider unpleaded abandonment issue); *Riceland Foods Inc. v. Pac. E. Trading Corp.*, 26 U.S.P.Q.2d 1883, 1884 (TTAB 1993) (refusing to consider unpleaded unregistered mark).

If a party obtains information during the course of a case which would form the basis for an additional claim, it "should move promptly to amend its pleading." TBMP §314. Here, Applicant's discovery response was dated October 10, 2008. (Opposer's Notice of Reliance, p.7). If Opposer believed that these responses created the basis for a fraud claim, it had more than a year to seek to amend the pleadings. It never did so. The issue cannot be raised now.

2. Nothing in the Record Supports a Claim of Fraud

Even if this Board were to consider the claim of fraud, the record shows that it is meritless. The Federal Circuit's recent decision in *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir.

2009) expressly overruled *Medinol Ltd. v. Neuro Vasx Inc.* 67 USPQ2d 1205 (TTAB 2003) and held that fraud is shown only where “the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.” *In re Bose Corp.*, 580 F.3d at 1245. The evidence of intent to deceive must be “clear and convincing.” *Id.* (quoting *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366 (Fed. Cir. 2008)).

Here, there is not a shred of evidence of Applicant’s intent, deceptive or otherwise. Indeed, there is no testimony from Applicant at all. The mere fact that Applicant chose not to adduce evidence of use of her mark on all of the goods covered by Applicant’s Application is meaningless, since she was under no obligation to do so.

Opposer’s knee-jerk assertion of fraud is procedurally out of order and factually baseless. Moreover, as discussed herein, the record is full of evidence directly contrary to Opposer’s assertion. Accordingly, the fraud argument should be disregarded.

VI. CONCLUSION

The record provides ample evidence of Applicant's use of the CAKEDIVA mark well before Opposer's alleged first use of the CAKE DIVAS mark, on October 15, 1998. Accordingly, and for the foregoing reasons, Applicant Charmaine Jones respectfully requests that the Board deny Opposer's Opposition 91177301 to Applicant's Trademark Application Serial No. 76/529,077.

Respectfully submitted,

Dated: February 17, 2009
New York, New York

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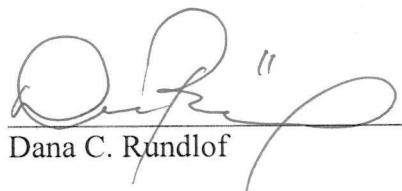
*Attorneys for Applicant,
Charmaine V. Jones*

CERTIFICATE OF SERVICE

I, Dana Rundlof, an attorney, hereby certify that a true and correct copy of the foregoing **APPLICANT'S BRIEF ON THE MERITS** was served by electronic means via the Trademark Trial and Appeal Board Electronic Filing System, and by first-class mail to the correspondent of record for Opposer as follows:

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Dated: February 17, 2010


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